



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/629,352	08/01/2000	James S. Bernardo	17924/301	6524

7590

04/04/2003

Craig J Lervick
Oppenheimer Wolff & Donnelly LLP
Plaza VII Suite 3400
45 South Seventh Street
Minneapolis, MN 55402

EXAMINER

SOUW, BERNARD E

ART UNIT

PAPER NUMBER

2881

DATE MAILED: 04/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/629,352

Applicant(s)

BERNARDO, JAMES S.

Examiner

Bernard E Souw

Art Unit

2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. The Amendment B, filed on 03/02/2003, Paper No.7/B, in response to the first Office Action dated 08/14/2002 has been entered. The present Office Action is made with all the suggested amendments being fully considered.

Claim 2 has been cancelled, claims 1 and 5 have been amended.

A new claim 44 has been added.

Accordingly, claims 1 and 3-44 are pending in this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 44 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a rejection based on New Matter.

The limitation that "*the frequency of measuring the operating characteristics of the luminaire is increased when the control unit determines that the luminaire is operating at less than a predetermined efficiency*", constitutes an introduction of New Matter not previously found in the original disclosure.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 9-14, 19-24, 28, 29 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman et al. (USPAT # 5,243,340), addressed hereafter as Norman'340, in view of Hardy et al. (UK Patent Application GB 2,176,640 A).

Norman'340 discloses a monitoring system for a luminaire shown by numeral 20 in Fig.3, comprising:

- a sensing unit 18 attached to the luminaire 20, so that sensing unit 18 can measure the electrical operating characteristics of the luminaire, wherein the electrical operating characteristics include the current and voltage at each of the input and output, as recited in Col.6/ll.1-2 and Col.6/ll.64-68, the latter reciting "voltage failure", which inherently means that the sensing unit 18 does not only monitor the status of the lighting, but also *measure at least the voltage* supplied to the luminaire.

While Norman'340 recites that AE unit 18 is used to monitor the status of the lighting (Col.6/ll.1-2), it is generally understood in the art that *monitoring the status of a lighting inherently* includes measuring the electrical operating characteristics of the luminaire, as unambiguously recited in Col.6/ll.64-68. Support for this Official Notice is provided by Hardy et al. on pg.1/ll.34-57, specifically reciting **voltage and current**

Art Unit: 2881

measurements on pg.1/ll.52-53, further on pg.2/ll.31-90 and on pg.3/ll.7-127, where it expressly recites "*apparatus 10 for determining the operational state of the equipment*", and also in the front page section (57)/ll.2-3, reciting each of the sensors 11-15 *sensing a respective operational parameter* of the equipment, which literally also recites measuring the electrical operating characteristics of the equipment.

While the above voltage and current measurements refer to the input to Norman'340's monitoring apparatus, Norman'340's system also includes current and voltage measuring devices in its output to the luminaires, which are known in the art as being inherent to the voltage regulator 41 in Fig.4, as recited in Col.6/ll.59-63.

Norman'340's system further comprises:

- a control unit 16 operatively coupled to the sensing unit 18 to receive measurements from the sensing unit 18, as disclosed in Col.6/ll.2-3;
- a monitor 4 operatively coupled to the control unit 16, as recited in Col.6/ll.3-4, to display on screen 6 an indication of the operative status of the luminaire 20, as recited in Col.6/ll.6-9 and shown in Fig.3.

These further limitations are also recited by Hardy et al., as recited in the front-page section (57) and on page 1/ll.31-49 and pg.2/ll.11-13, the latter specifically reciting *a display unit*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include Hardy's measuring devices for current, voltage, and other operating parameters in Norman'340's monitoring system, as well as a display unit, since these devices are standard equipment for monitoring electrical systems.

Art Unit: 2881

► Regarding claim 5, Norman'340's control unit 4 or 14 shown in Fig.3, controls an associated system, i.e., lamp control unit 35 equipped with microprocessors and associated interfaces 37 shown in Fig.4, when the control unit determines that the luminaire is inoperative and *a backup means is not available*, as recited in Col.6/II.32-58. The newly added limitation "*a backup means is not available*" is trivial for being conventional, since one of ordinary skill in the art would not be motivated to control an associated system when the operation of the luminaire system can be more easily reinstated by activating a backup system.

► Regarding claims 9, 12-14, 21-24 and 35, Norman'340's sensing unit 18 is a (plurality of) lighting electronic unit(s) (Col.2/II.32-34), which inherently includes voltage and current measuring devices in the *input* to the monitoring system, as generally known in the art and also implicated by Norman'340' in Col.6/II.64-68. This Official Notice is supported by Hardy et al., as already applied to claim 1 above. Norman'340's monitoring system also includes current and voltage measuring devices in the output to the luminaires, which are known in the art as being inherent to the voltage regulator 41 in Fig.4, as recited in Col.6/II.59-63.

► Regarding claims 10, 11, 19, 20, 29 and 37, Norman'340's monitoring system includes a master controller 4 or 14 shown in Fig.3, coupled to a related device for providing control signals which will effect the operation of the related device based on the condition of at least one of the plurality of luminaires 20, as recited in Col.6/II.64-68 regarding a battery back-up to be activated in case of power failure, and in Col.3/II.17-

Art Unit: 2881

23 as well as in the Abstract/II.7-10 regarding a second set of luminaires to be activated in case of a (filament) failure of at least one of the operating luminaires.

Note: The language of claims 19 and 20 does not exclude a battery back up system (Norman'340 Col.6/II.64-68) and/or an entire second luminaire system (Norman'430 Col.3/II.17-23 and Abstract/II.7-10) as a "*related*" system. However, the "*related*" system in claims 19 and 20 can also be alternatively interpreted as lamp control unit 35 equipped with microprocessors and associated interfaces 37 shown in Norman'340's Fig.4, as previously applied to claim 5.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include battery back-up system and a second set of luminaires, to be activated by a master controller whenever needed in Norman'340's monitoring system, in order to prevent an interruption of the luminaire's function that may cause undesirable, or even dangerous & hazardous circumstances.

► Regarding claims 28 and 36, Norman'340's monitoring system includes a display screen 6 shown in Fig.3 for providing a visual indication regarding the operational status of the plurality of luminaires 20, as recited in Col.6/II.6-9.

4. Claims 3, 6, 7, 15-17, 25-27, 31-34 and 39-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman'340 in view of Hardy et al., and further in view of Grebe et al. (USPA # 5,973,616).

Norman'340 as modified by Hardy et al. recite all the limitations of claims 3, 6, 7, 15-17, 25-27, 31, 39, 42 and 43, as previously applied to their respective parent claims

Art Unit: 2881

1, 5, 9, 21, 29 and 37, except for specific recitations that are rendered obvious by Grebe et al., as described in the following:

► Regarding claims 3, 15-17, 25-27, 42 and 43, Hardy's monitoring system shown in the sole figure includes a transmitter 27 coupled to the control unit 16 for transmitting data and a receiver 32 coupled to the monitor 36 for receiving data (as well as a receiver 26 connected to the controller 16 and a transmitter 31 connected to monitor 36), so that the monitor can display the indication of the operative status of the luminaire as recited

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a transmitter/receiver, a transceiver, or a pager, in order to quickly get a help for handling an acute situation that is dangerous or hazardous.

► Regarding claims 6, 7, 31-34 and 39-41, in case of a luminaire failure Norman's monitoring system as modified by Hardy et al. is used to control and/or activate a back-up system, which includes a second system of luminaires, as already recited previously in the rejection of claims 5, 10, 11, 19, 20, 29 and 37. This second system may be a traffic light as disclosed by Grebe et al., and/or a street light as inherent in both Norman's 340's and Hardy's inventions (airport lighting also encompasses airport traffic lights). Especially regarding claim 33, to make the traffic light flash is well-known in the art, and is conventionally understood as a warning.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to automatically or expediently change the operation status of a

(nearby or especially installed) traffic light, as taught by Grebe et al., whenever needed in order to influence the traffic as an emergency measure.

A specific motivation to combine the prior arts is here not needed, since it is within the general skill and capability of any person having ordinary skill in the pertinent art, drawn from the specific condition of the emergency situation(s), that such a person would have been able to anticipate. This literally means, the *motivation to do so is inherent*, i.e., found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norman'340 in view of Hardy et al., and further in view of Chen (USPAT # 6,060,994) or Petite (USPAT # 6,218,953 B1).

Norman'340 as modified by Hardy et al. shows all the limitations of claim 4, as previously applied to the parent claim 1 above, except the recitation of coupling the monitor to the Internet.

Chen discloses a monitoring system for electrical devices (that may as well include lamps and luminaries), as recited in the Title as well as the Abstract. Chen's monitor 4 shown in Fig.1 is connected to the Internet, as recited in Col.2/ll.34-37, so that remote access is provided to the monitor, as further recited in Col.2/ll.37-39.

Alternatively, Petite describes a monitoring system for electrical devices (that may as well include lamps and luminaires), as recited in the Title as well as the Abstract. Petite's central monitor 118 shown in Fig.10 is connected to the Internet, as disclosed in Col.13/II.22-25.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to connect Norman'340's or Hardy's central monitor to the Internet, since this is today a popular way to provide any participant a comprehensive information about the electrical system being watched, including an access to a visual display of the current situation. There is no motivation needed, since utilizing the Internet to convey messages and visual displays is as desired as well known to everybody, even to those not particularly skilled in the pertinent art.

6. Claims 8, 30 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norman'340 as applied to claims 5, 29 and 37 above, and further in view of Hamm et al. (USPAT # 5,774,052).

Norman'340 as modified by Hardy et al. shows all the limitations of claims 8, 30 and 38, as previously applied to the parent claims 5, 29 and 37 above, except the recitation of using controlling an ATM when the luminaire surrounding it is inoperative.

Hamm et al. describe a monitoring system that observes the light level surrounding an ATM, as recited in the Abstract/II.7-10. Hamm's ATM is temporarily shut down, if the light level does not reach or maintain the desired light level, such as a condition caused by a failure of the lighting system, as recited in the Abstract/II.10-16.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Norman'340's system as modified by Hardy et al. for monitoring the light level surrounding an ATM, so that the ATM may be shut down if the latter is not sufficiently illuminated, as taught by Hamm et al., in order to reduce the statistics of criminal acts committed at ATMs, as suggested by Hamm et al. in Col.1/II.37-48.

7. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norman'340 in view of Hardy et al., and further in view of Pavarotti et al. (USPAT # 5,644,304)

Norman'340 as modified by Hardy et al. shows all the limitations of claim 18, as previously applied to the parent claim 9 above, except the recitation of directly connecting the monitoring equipment and the controller system via a communication bus.

Pavarotti et al. disclose an automatic monitoring & controlling system shown in Fig.5, which transfers data from a monitoring unit to a remote computer through a Communication Bus, as recited in Col.6/II.46-51.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a Communication Bus for data transfer between remotely located computers, since this is a conventional method for which standard interfaces are readily available.

8. Insofar as the Examiner can ascertain beyond the above § 112 rejection, even if claim 44 would have qualified as not being a New Matter, the limitation that "*the frequency of measuring the operating characteristics of the luminaire is increased when the control unit determines that the luminaire is operating at less than a predetermined efficiency*", only represents an automation of a routine that is normally done by an operator in a manual and conventional manner. It has been held by the court that broadly providing a mechanical or automatic means (i.e., an automatic mechanism to *increase the frequency of measurement* under a conventionally well known condition) to replace manual activity which has accomplished the same result, involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

Final Rejection

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Applicant's Arguments

9. Applicant's arguments filed on 03/02/2003 have been fully considered but they are not persuasive. The following is Examiner's response to Applicant's arguments.

Misinterpreting the Cited Prior Art(s)

10. In response to applicant's arguments (1) to (2) on page 3-4 of paper no.7/B, insisting that Norman'340's provision of monitoring the operational status of the luminaire does not include measuring voltage and current, it is noted that Applicant is misinterpreting Norman'340's invention by "reading" things not recited in the prior art, since Norman'340 clearly recites in Col.6/ll.66-67 a case of voltage failure of the luminaire. How would Norman'340 be able to distinguish a *voltage* failure from a defective lamp, if Norman'340's is just monitoring the (general) status of the luminaire without explicitly measuring the voltage?

Thus, from this fact alone, one of ordinary skill in the art must conclude that Norman'340's provision of monitoring the operational status of the luminaire ***must inherently*** also include *measuring voltage* and *current* applied/consumed by the individual lamps.

Furthermore, the fact that monitoring the operational status of a luminaire inherently also includes measuring voltage and current is conventional and also generally known in the art. This Official Notice is supported by Hardy et al., which

recites a determination of operational status on pg.1/II.34-57, more specifically in lines 34-39, 50-52 and 55-56, where voltage and current measurement is expressly recited in lines 52-53.

Although the previous § 102 rejection is *proper* because of the *inherency* implicated by Norman'340 in Col.6/II.66-67, the Examiner is ready to change the previous rejection into a § 103 rejection with Hardy et al. as secondary prior art, or more precisely, a support for an Official Notice taken by the Examiner.

11. In response to applicant's argument (3) on page 4 in paper # 7/B, insisting that Norman'340's merely teaches depicting the status of the entire plant on screen 6 or printer 10, but not the status of the individual lighting, it is noted that an entire plant consists of individual lighting, and that without knowing the status of individual lighting it is impossible to know the status of the entire plant. Thus, Applicant is inverting the logic and thus misinterpreting the cited prior art. One would not need a computer and a display screen just to depict the general status of the entire plant; a red-green light signal would be sufficient. On the other hand, given that one is equipped with a computer and a monitor screen, he/she of ordinary skill in the art would effectively use the equipment to monitor the status of the individual lighting, including its individual voltage, current and other operating parameters. To come up with such an effective usage, one does not need an auxiliary teaching, but one may rely solely on his/her ordinary knowledge in the art. Only those of inadequate and inferior knowledge in the art will not be able to do that.

Applicant's argument is thus unpersuasive, because it is illogical, and is based on a misinterpretation of Norman'340 prior art. Consequently, the previous § 102 rejection is proper, although the Examiner is ready to change it into a § 103 rejection

with Hardy et al. as a secondary prior art. The output from Hardy's sensors 11-15 shown in the sole figure are stored in the memory 17 of the control circuit 16, as recited in pg.3/ll.15-124. These data are then transmitted to the control panel with digital display unit 36, as recited in pg.4/ll.78-98, whereby a single interrogator means 30 is able to display information of the entire plurality of luminaires stored in memory 17, as expressly recited in pg.4/ll.86-98.

12. Applicant's arguments regarding the *prima facie* obviousness of previous § 103 rejections on pages 4-7 (a) to (c) in paper no.7/B are all unpersuasive, because they are based on a generally and fundamentally wrong premise on previous rejections of all independent claims 1, 9, 21 and 35, which originate from Applicant's misinterpretation of the Norman'340 prior art, now further supported by Hardy's.

Especially regarding claims 5, 19 and 20 argued in item (c), Applicant's claim language does not exclude a battery back up system, an entire second system, and an ATM, as an "associated system" or "related system" recited in Applicant's claims, thus rendering Applicant's argument unpersuasive.

Specifically regarding claims 29 and 37 argued in item (c), Applicant's argument that Norman'340 fails to teach that the master controller provides control signals based on the condition of the (individual) luminaires and based on any condition of the lamps, is deemed unpersuasive because it is based on Applicant's misinterpretation of the Norman'340 prior art, now further supported by Hardy's.

13. Applicant's arguments (d) on pg.7-8 in paper no. 7/B, regarding the previous § 103 rejections of claims 3, 6, 7, 15-17, 25-27, 31-34, and 39-43, over Norman'340 and Grebe, now supported by Hardy et al. for the Official Notice inherent in the first Office

Action, are all based on Applicant's misinterpretation of Norman-340's prior art, and therefore fail to support Applicant's entire arguments against the rejections of record.

As already recited in the above new § 103 rejections of claims 3, 15-17, 25-27, 42 and 43, Hardy's monitoring system shown in the sole figure includes a transmitter 27 coupled to the control unit 16 for transmitting data and a receiver 32 coupled to the monitor 36 for receiving data, so that the monitor can display the indication of the operative status of the individual luminaire.

14. Regarding applicant's argument (e) on page 8 in paper # 7/B, Applicant fails to obviate the previous rejection of claim 1, now reinforced with Hardy et al. as a support for the previous Official Notice made by the Examiner. Hence, Applicant's argument regarding claim 4 is unpersuasive.

15. Regarding applicant's argument (f) on page 8 in paper # 7/B, Applicant fails to obviate the previous rejection of claims 1, 21 and 35, now reinforced with Hardy et al. as a support for the previous official Notice made by the Examiner. Hence, Applicant's argument regarding claims 8, 30 and 38 is unpersuasive.

16. Regarding applicant's argument (g) on page 8 in paper # 7/B, Applicant fails to obviate the previous rejection of claim 9, now reinforced with Hardy et al. as a support for the previous official Notice made by the Examiner. Hence, Applicant's argument regarding claim 18 is unpersuasive.

Unpersuasive Arguments

"No Suggestion or Motivation to Combine"

17. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

(a) In a specific case, the rationale to modify or combine the prior arts of Norman'340 and Hardy et al. i.e., to display of the status of individual lighting (Hardy et al.) instead of --or in addition to-- of the general status of the entire plant on screen, as Applicant has misinterpreted from Norman'340's invention, does not have to be expressly stated in the prior arts; in the present case the rationale is reasoned from knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

This relates to suggestion/motivation in that "having established that this knowledge was in the art, the Examiner could then properly rely on a conclusion of obviousness 'from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference'." *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

(b) In another specific case, Applicant's argument that measuring voltage and current in Norman's would be useless (page 9, Applicant's paper # 7/B), is a complete nonsense, and hence, unpersuasive, as demonstrated by Hardy et al. which explicitly

disclose what is readily inherent in Norman'340, i.e., measuring the voltage and current, as well as other relevant operating parameters of individual luminaires.

(c) In another specific case regarding claims 6, 7, 31-34 and 39-41, Applicant's argument against a suggested motivation to combine Norman'340 and Grebe references, specifically Applicant's quotation of the Examiner's words, "A specific ***motivation to combine*** the prior arts is here not needed ..", is to be *strongly rejected* for eliminating a large part of the original and complete statement in the Examiner's Office Action, which continues with "... (is here not needed), since it is within the general skill and capability of any person having ordinary skill in the pertinent art, drawn from the specific condition of the emergency situation(s) that such a person would have been able to anticipate." Obviously, Applicant is here misinterpreting the Examiner's statement, which correctly means, the *motivation to do so is inherent*, i.e., found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Consequently, Applicant's further argument regarding "specific rationale", "objective evidence of record", etc., which invariably also means a need for auxiliary teaching from prior art, are all unpersuasive.

The same thing is to be understood with the Examiner's statement in the rejection of claim 4, that there is no motivation needed, since utilizing the Internet to convey messages and visual displays is as desired as well known to everybody, even to those not particularly skilled in the pertinent art.

Arguing Limitations which are not claimed

18. Regarding Applicant's argument that a battery back up system, an entire second luminaire system, or an ATM machine, all recited in Norman'340's, do not count as an "associated" or "related" system meant in Applicant's claims, including 5, 19 and 20, it is noted that the language of original claim 5, as well as claims 19 and 20 does not exclude a battery back up system, an entire second luminaire system, nor an ATM machine. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

CONCLUSION


19. For the above-indicated reasons, all previous rejections are proper, although the Examiner is ready to change the previous § 102 rejections into corresponding § 103 rejections with Hardy et al. as an additional prior art, the latter representing more a support for an Official Notice for the inherency in Norman'430's. Consequently, all claims are now rejected also with Hardy et al. as an additional prior art under the same or very similar reasons of record.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernard E Souw whose telephone number is 703 305 0149. The examiner can normally be reached on Monday thru Friday, 9:00 am to 5:00 pm..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R Lee can be reached on 703 308 4116. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9318 for regular communications and 703 872 9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.

bes
March 11, 2003


JOHN R. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800